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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/509,055	03/20/2000	HANS-DIETER HECKER	P00.0069	7794

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EXAMINER

KIDD, MARKY M

ART UNIT

PAPER NUMBER

2645

DATE MAILED: 03/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/509,055

Applicant(s)

HECKER, HANS-DIETER

Examiner

Marky M Kidd

Art Unit

2645

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 20 March 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 9-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 9-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on 20 March 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. Claims 9-11 and 18 are rejected under 35 U.S.C. 102(e) as being unpatentable by Shaffer et al (US Patent Number 6,240,170).

Regarding **claim 9**, Shaffer discloses a method in a telecommunications system for automatically translating messages transmitted by a calling party to a called party (column 1, lines 37-40). The method consist of the following steps:

Storing selector information designating a language that is allocated to a relevant subscriber for internal subscribers in the communication system (column 4, line 2);

Comparing the selector information of a calling subscriber, when a connection is set up, to the selector information of the called subscriber (column 2, lines 55-58) ; and

Automatically activating a loop-in function, when items of the selector information of the calling subscriber differ from the selector information of the called subscriber, which effects an insertion of a translator into the connection (column 2, lines 59-61 and column 3 lines 27-31) .

Regarding **claim 10**, Shaffer discloses a method consisting of storing display texts (, in the communications system, for a dialog operator interface (figure 1 item 57) of internal terminal devices (language database, figure 1 item 62) in several languages (column 4, lines 7-12).

Regarding **claim 11**, Shaffer discloses a method consisting of forming the selector information dependent on the language of the display text for the dialog operator interface that is selected by a subscriber (column 4, lines 3-5).

Regarding **claim 18**, Shaffer discloses a communication system (telecommunication system) for translating messages that are directed to a called subscriber into a language that depends on the called subscriber that consist of the following:

A text memory in which display text for a display operator interface of internal terminal device are stored in several languages (column 1, lines 36-39);

Subscriber-specific storage elements in which an item of selector information that identifies a language that has been selected for the subscriber terminal in respectively stored (column 4, lines 2-5);

At least one translator (language database 62) for translating at least one of spoken language and text (column 2, lines 50-52); and

A control unit (central processing unit 60) for controlling a loop-in function that effectuates an insertion of a translator into a connection between the called subscriber and a calling subscriber in cases when the selector information allocated to the called subscriber is

different from the selector information allocated to the calling subscriber (column 2, lines 59-61 and column 3 lines 27-31).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. **Claims 12-15** are rejected under 35 U.S.C. 103(a) as being unpatentable over Shaffer in view of Toshiba (European Patent Application 0311416).

Regarding **claims 12 and 14**, Shaffer discloses a communication system (telecommunications system) for translating messages that are directed to a called subscriber as set forth in the limitations of claim 9. However, Shaffer is silent on the issue of a calling terminal device and a called terminal device are allocated to different communication systems, the selector information is transmitted from the communication system of the calling terminal device to the called terminal device, and/or the selector information is transmitted from the communication system of the called terminal device to that of the called terminal device. Toshiba discloses a translating communication system that automatically translates communications between communication terminals in different languages (column 1, lines 9-14). The communication system is able to translate information between communication terminals simultaneous (column 2, lines 53-58). The communication system is equipped with a speech synthesis that allows the different communication terminals to understand the communication being presented (column 3, line 28). Figure 2 of Toshiba shows two separate communication

systems that translate and transmit communication between both the calling and called terminal devices (column 4, lines 43-64). Therefore, it would of have been obvious at the time of the invention to modify the system of Shaffer to include the two communication systems of Toshiba to allow translating and transmitting of communication between the called and calling terminal devices.

Regarding **claims 13 and 15**, Shaffer and Toshiba disclose a communication system (telecommunications system) for translating messages that are directed to called subscriber as set forth in the limitations of claims 12 and 14. Shaffer further discloses a method consisting of transmitting the selector information in the framework of an ISDN call signaling (column 2, lines 29-31 and 34-36). Shaffer's communication system is equipped with a decoder and ANI, which is well known in the art to incorporate ISDN call signaling in a voice mail environment.

5. **Claim 16** is rejected under 35 U.S.C. 103(a) as being unpatentable over Shaffer in view of Goldstein (European Patent Application EP 0601710A2).

Regarding **claim 16**, Shaffer discloses a communication system (telecommunications system) for translating messages that are directed to a called subscriber as set forth in the limitation of claim 9. However, Shaffer is silent on the issue of deactivating the automatic function of translating messages based off stored selected languages. Goldstein discloses a language interpretation service that allows a subscriber to enter a service refusal code to deactivate the interpretation service (column 5, lines 50-58 and column 6 line 6). It would have been obvious at the time of the invention to modify the system of Shaffer to include the method of Goldstein to allow subscribers of the communication system to receive messages in the original format.

6. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shaffer in view of Danial (US Patent Number 5940806).

Regarding **claim 17**, Shaffer discloses a method in a communications system for translating messages that are directed to a called subscriber. Shaffer, however, is silent on the issue of the message to be translated is at least one of a voice message, fax message, video message, and a message for electronic mail. Danial discloses a programmable computer that provides data items based off profile (language) specified by the user (Abstract, lines 1-4). The system determines the language the user would like the request to be processed whether it's a voice, fax, video, or email message (column 5, lines 1-10). It would have been obvious at the time of the invention to modify the system of Shaffer to include the method of Danial in order to accept different types of messages that users may want to access and have translated.

Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marky M Kidd whose telephone number is 703-305-8149. The examiner can normally be reached on Monday-Friday 7:30am-4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on 703-305-4895. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-5403 for regular communications and 703-308-5403 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-306-0377.

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Marky M Kidd
Examiner
Art Unit 2645

February 10, 2003

FAN TSANG
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600

A handwritten signature in black ink, appearing to read 'Fan Tsang', with a stylized, flowing script.